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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,923	07/25/2001	James M. Tour	1789-05303	5497

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EXAMINER

MARSCHEL, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/912,923

**Applicant(s)**

TOUR ET AL.

**Examiner**

Ardin Marschel

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/28/03, 3/23/04, 4/5/04, & 8/20/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,23-26,28-31,33-42 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,23-26,28-31,33-42 and 57 is/are rejected.
- 7) ☒ Claim(s) 21 & 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicants' arguments; filed 11/28/03, 3/23/04, 4/5/04, and 8/20/04; have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### **NEW MATTER**

Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 57 now requires the "consecutive" ordering of steps which has not been found as filed nor pointed to by applicants. This new limitation therefore is NEW MATTER. This rejection is necessitated by amendment.

### **VAGUENESS AND INDEFINITENESS**

Claims 21, 23-26, 28-31, 33-42, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21, part (b), cites the reconfiguration of molecular circuit components, however, lacks such a reconfiguration directed to either "nanoscale components" or "the combination thereof" as cited in part (a). Thus, the programming step (b) now appears

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to incompletely program options within part (a). Clarification via clearer claim wording is requested. Claims which depend directly or indirectly from claim 21 also contain this unclarity due to their dependence. This rejection is necessitated by amendment.

Claim 34, line 2, cites a step "(b3)" but confusingly lacks any description as to what step "(b3)" is. It is noted that claim 34, line 7, deletes a reference to step "(b3)". Clarification via clearer claim wording is requested. Claim 57 also contains this unclarity due to its dependence from claim 34. This rejection is necessitated by amendment.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 23-26, 28-31, and 33-38 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by any one of Chen et al. (P/N 6,518,156) or Edman et al. (P/N 6,569,382) or Heath et al. (P/N 6,459,095).

This rejection is reiterated and maintained from the previous office action, mailed 8/25/03. Applicants argue that the references neither disclose a random array of molecular components nor applying a self-adaptive algorithm to reconfigure the molecular circuit components. In response, firstly, the instant claims are not limited to such a random array because the amendment to claim 21, part (a), optionally requires

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that the nano-network is either a "random array or molecular circuit components" or "nanoscale components". The second option of "nanoscale components" lacks any random limitation and is clearly yet anticipated by the nanoscale device components of the references. The second argument regarding a self-adaptive algorithm also is not persuasive because the programmability of components in the references is reasonably a characteristic self-adaptive characteristic which is also an algorithm based on the data control resulting from the program implemented via their programmability.

### INFORMALITIES

The disclosure is objected to because of the following informalities:

In the section on page 1 of the specification in the section entitled "CROSS REFERENCE TO RELATED APPLICATIONS", the U.S. Patent Application Serial Number "09/551.716" confusingly contains a period where a comma generally is utilized within the application number. This period within this same serial number is also present in the specification in paragraph [0032].

In claim 21, lines 5 and 6, a confusing different spacing is present in "nano-network" vs. "nano- network", respectively, which may be interpreted as indicating some difference therebetween.

In claim 34, line 2, the word "tile" appears to be misspelled.

Appropriate correction is required.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 12, 2004

*Ardin H. Marschel 11/12/04*  
ARDIN H. MARSCHEL  
LEGAL INSTRUMENT EXAMINER